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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,635	11/02/2001	Joseph C. Salamone	P02866	8360

7590

11/02/2004

Bausch & Lomb Inc.
One Bausch & Lomb Place
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EXAMINER

PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,635

Applicant(s)

SALAMONE ET AL.

Examiner

Kuo-Liang Peng

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/11/04 Amendment.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) 1-6 and 14-18 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 7-13 and 19-28 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The Applicants' amendment filed on August 11, 2004 was received. Claim 7 is amended.
2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 0504) is/are removed.
3. The text of those sections of Title 35, U.S. code not included in this action can be found in a prior Office Action (Paper No. 0504).

Claim Rejections - 35 USC § 102 and 103

4. Rejection of Claims 7-13 and 19-28 under 35 USC 102(b) as being anticipated by Kunzler (US 5 710 302) is maintained because the rejection is adequately set forth in paragraph 5 of Paper No. 0504. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants argue that Kunzler's monomeric units (i.e., Formula I) contain fluoroalkyl groups, however, the monomer recited in Claim 7 does not contain

Art Unit: 1712

fluoroalkyl groups. However, Applicants should notice that Kunzler's formula VI that does not contain fluoroalkyl groups reads on the monomer recited in Claim 7.

5. Rejection of Claims 7-11, 13, 19-28 under 35 USC 102(b) as being anticipated by and rejection of Claim 12 under 35 USC 103(a) as being unpatentable over Meijs (US 5 981 615) are maintained because the rejections are adequately set forth in paragraphs 6 and 8 of Paper No. 0504. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

Applicants argue, "To the contrary, the soft, flexible compositions of the present invention are monofunctional monomers not bisfunctionalized macromonomers as taught by Meijs." (Remarks, page 13, last paragraph) As mentioned in the previous Office action, Meijs discloses the use of a macromer of formula (IVA) which can be a residue of monohydroxyalkyl-terminated poly(dimethylsiloxane). It is noted that "bishydroxyalkyl" is a typographical error, and should read "monohydroxyalkyl" because the macromer of formula (IVA) is clearly a monofunctional macromer. Thus, the rejections based on Meijs are adequate.

Art Unit: 1712

6. Claims 7-12 and 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Lesko (US 5 897 811).

Lesko discloses a polymeric composition produced by polymerizing a monomer mixture comprising allyl tris(trimethylsiloxy)silane, etc. (col. 4, lines 13-41) and the ethylenically unsaturated monomers having pendant fluorescent functionality described in col. 3, lines 12-24. col. 4, lines 13-41) Note that the relative amount of the ethylenically unsaturated monomers having pendant fluorescent functionality is very small compared to that of the allyl tris(trimethylsiloxy)silane, etc. (col. 3, lines 38-47) Since Lesko's polymeric composition is substantially the same as Applicants' polymeric composition. Both of them should possess similar properties such as modulus, etc. Lesko further teaches the use of 2-ethylhexyl (meth)acrylate, etc. (col. 3, line 48 to col. 4, line 12) Lesko further teaches the use of hydrophilic monomers as described in col. 4, lines 8-12. Lesko further teaches the use of cyclopentyl methacrylate, etc. (col. 4, lines 1-12). Lesko further teaches the use of crosslinkers. (col. 9, lines 11-31)

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

Art Unit: 1712

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an

Art Unit: 1712

application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
October 28, 2004


KUO-LIANG PENG
PRIMARY EXAMINER

Kuo-Liang Peng
Primary Examiner
Art Unit 1712